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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/611,279	01/17/2001	Richard A. Mazur	47171-00269USC1	6737

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EXAMINER	
SHAPIRO, JEFFERY A	
ART UNIT	PAPER NUMBER
3653	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/611,279	Applicant(s) MAZUR ET AL.	
	Examiner Jeffrey A. Shapiro	Art Unit 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 October 2002*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *169-187, 189, 190, 192-201, 221-224, 234-248, 250-257, 268-272, 277-285, 301-305, 312-314, 317-319, and 322-329* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *169-187, 189, 190, 192-201, 221-224, 234-248, 250-257, 268-272, 277-285, 301-305, 312-314, 317-319, and 322-329* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

No attachments. JAS 3-8-03

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/24/02 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 164-329 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishida et al (US 5,419,423).

Ishida et al discloses the method of evaluating a stack of bills as follows.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;

3. determining whether the bills meet or fail to meet a non-piece count related criterion;

4. halting the transporting when a bill meets or fails to meet the criterion;

5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

4. Claims 164-329 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takesako.

Takesako discloses the method of evaluating a stack of bills as follows.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;

3. determining whether the bills meet or fail to meet a non-piece count related criterion;

4. halting the transporting when a bill meets or fails to meet the criterion;

5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

5. Claims 164-329 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa et al.

Takizawa et al discloses the method of evaluating a stack of bills as follows.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;

3. determining whether the bills meet or fail to meet a non-piece count related criterion;

4. halting the transporting when a bill meets or fails to meet the criterion;

5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

6. Claims 164-329 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshihara.

Yoshihara discloses the method of evaluating a stack of bills as follows.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;

3. determining whether the bills meet or fail to meet a non-piece count related criterion;

4. halting the transporting when a bill meets or fails to meet the criterion;

5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

7. Claims 164-329 are rejected under 35 U.S.C. 103(a) as being unpatentable over McInerny.

McInerny discloses the method of evaluating a stack of bills as follows.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;

3. determining whether the bills meet or fail to meet a non-piece count related criterion;

4. halting the transporting when a bill meets or fails to meet the criterion;

5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

8. Claims 164-329 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walkley et al.

Walkley et al discloses the method of evaluating a stack of bills as follows.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles;

3. determining whether the bills meet or fail to meet a non-piece count related criterion;

4. halting the transporting when a bill meets or fails to meet the criterion;

5. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Note that whatever the rate of bills counted per minute, the apparatus of Ishida et al nonetheless operates such that the method of Applicants' is necessarily performed.

9. Claims 164-329 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takizawa et al in view of Takesako. Takizawa discloses the following.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. counting and determining the denomination of the bills utilizing a detector positioned along a transport path between the input receptacle and the output receptacles (see col. 2, lines 23-28);

2. determining whether the bills meet or fail to meet a non-piece count related criterion (note that genuineness of a bill is construed to be a non-piece count related criterion as it does not relate to the denomination or the order of the bills);

Takizawa does not expressly disclose the following.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. halting the transporting when a bill meets or fails to meet the criterion;

3. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles;

Takesako et al disclose the following.

As described in the independent claims 164, 204, 209, 214, 259, 268, 273, 290, 301, 306, 322 and 326;

1. transporting the bills, one at a time, from the input receptacle to one of two or more output receptacles of the currency evaluation device;

2. halting the transporting when a bill meets or fails to meet the criterion; (Note that, at the very least, it would be an obvious alternative to halt the transporting of a single bill when a single bill fails to meet a specific criterion. In addition, it would have been a matter of design choice

as to what criterion to check for based upon the situational requirements. Also, note that, as Applicant has pointed out in col. 2, lines 54-59, rejected bills are stacked in a reject stacker. However, it is considered that a single stack could consist of a single bill, which could be a single rejected bill, and which could be sent to the reject bin—in other words, a rejected stack could consist of a single rejected bill. In addition, the number of reject bins could be a matter of design choice. In theory, one could have a single reject bin for each rejected bill.)

3. the halting is performed such that the flagged bill is positioned as the last bill in one of the output receptacles; (Again, note that, since one bill may be considered to be a reject bill, and could make up a single stack, it could be positioned as the last bill in one of the output receptacles. In addition, note that it would be an obvious variation to place a flagged bill as the last bill in an output receptacle. Note also, col. 2, lines 50-52, which discloses interruption of the transportation of bills so that an operator can take out a stack of bills. Such an interruption operation for allowing a single rejected bill to be removed would be an obvious variation of Applicant's process steps. See also McInerny, col. 7, lines 48-55, which describes detecting misfed or unfit documents in which the device is halted so that the user may remove the document.)

Note that whatever the rate of bills counted per minute, the apparatus of Takesako et al or Takizawa et al nonetheless operates such that the method of Applicants' is necessarily performed, or is capable of being performed.

Both Takesako et al and Takizawa et al are analogous art because they both concern the bill handling and sorting art.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the double outputs of Takesako et al in the device of Takizawa et al.

The motivation/suggestion for doing so would have been to improve work output and efficiency.

Therefore, it would have been obvious to combine Takesako et al and Takizawa et al to obtain the invention as specified in Claims 164-329.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 164-329 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the Claims of each of the following U. S. Patent No.'s individually. They are;

5,295,196; 5,430,664; 5,467,405; 5,790,697; 5,806,650;5,815,592; 5,867,589; 5, 870,487; 5,875,259; 5,905,810; 5,992,601; 6,012,565; 6,073,744; 6,220,419 B1; 6,237,739 B1; 6,241,069 B1; 6,278,795 B1; 6,311,819 B1(currently unavailable).

Although the conflicting claims are not identical, they are not patentably distinct from each other because they either claim an apparatus that can perform the method, a method, or a combination of method and apparatus directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

12. Claims 164-329 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 164-327 of both copending Application No.'s 09/541,170 and 09/542,487; Claims 157, 158 and 164-190 of copending Application No. 09/635,967; Claims 164-337 of copending Application No. 09/607,019; Claims 1-145 of copending Application No. 09/684,103, claims of Application No. 09/126,580. Although the conflicting claims are not identical,

they are not patentably distinct from each other because they are directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Examiner notes that Application 09/864,423, which is commonly owned by the Applicants is currently unavailable to the Examiner for review of double patenting issues.

Response to Arguments

13. Applicant's arguments filed 3/4/02 have been fully considered but they are not persuasive. Applicant asserts with respect to Ishida, Takizawa, and Yoshihara do not disclose receiving a stack of bills in an input receptacle and counting the denomination of bills. It is considered that receiving bills in the form of stacks is well known in the art as a form to present bills to a bill sorting apparatus. Note, for example, Takesako. Regarding the counting of bill denominations, it is considered obvious that one skilled in

the art would be able to obtain bill denomination based upon the detected bills and count said bills. Bill sorting apparatus' are well known as also having means for counting said detected bills. For example, note Takizawa et al, in col. 2, lines23-28, which describe detecting the denomination and authenticity of a bill. It would be unthinkable as to why an automatic cash/deposit/dispensation machine or vending machine (see col. 1, lines 5-18) would not count said bills. Yoshihara has similar discussion in col. 1, lines 9-21, noting that "such apparatus and method capable of performing accurate validation and collation..."

Ishida et al is also intended to be used in the environment of a vending machine, which inherently accounts for the bills detected. Note in col. 1, lines 5-10, that the apparatus of Ishida et al is disclosed as discriminating between true and false bills. Further, as this device is considered to be part of a vending machine, it is, at the very least, considered to be inherent that the device would interface with the vending machine, which could be expected to be able to determine the denomination of the bill.

Regarding McInerny, it is considered that receiving stacks of bills and feeding them to two or more output receptacles would be a matter of design choice, based upon the output or workflow required. Again, regarding determination of the denomination of bills, it would be expected that an apparatus that counts and batches bills (see col. 3, lines 58 and 59) would necessarily have to determine the denomination of the bills in order to function. In addition, note in col. 1, lines 18-21, which states that bill "counting and handling devices are known which count, verify and stack a particular type of document, such as currency." In lines 22-25, it is stated that this is accomplished

through detection of optical and magnetic characteristics of the bills. Such detection characteristics are inherently able to yield denomination of particular bills as the U.S. Treasury, for example, provides a particular magnetic strip for a specific type of denomination within each bill.

Therefore, Claims 1 and 164-337 are rejected, as discussed above.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone numbers for the organization where this application or proceeding is assigned are (703)306-4195 for regular communications and (703)306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Jeffrey A. Shapiro
Patent Examiner,
Art Unit 3653

DONALD P. WALSH
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March 10, 2003